IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	**Mail Stop AF**
)	
Koji Naito et al.)	Group Art Unit: 2625
)	
Application No.: 09/820,688)	Examiner: James A. Thompson
)	
Filed: March 30, 2001)	Confirmation No.: 8787
)	
For: IMAGE PROCESSING)	
APPARATUS, IMAGE FORMING)	
APPARATUS, INFORMATION)	
EMBEDDING METHOD, AND)	
INFORMATION EMBEDDING)	
PROGRAM)	
)	

PRE-APPEAL BRIEF CONFERENCE REQUEST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated March 10, 2009, a Pre-Appeal Brief

Conference is requested.

Claims 1, 3-7, 9-13, 15-20, and 22-29 are pending.

The Office Action rejects claims 1, 3, 5-7, 9, 11-13, 15, 17-20, 22 and 24-29

under 35 U.S.C. §103(a) over U.S. Patent No. 6,577,746 to Evans et al. in view of

U.S. Patent No. 5,987,127 to Ikenoue et al. This rejections is respectfully traversed.

Evan Does Not Disclose Detecting and Storing Additional Information in

Association with Location Information

Applicants' independent claim 1 is directed to an image processing apparatus

including, among other elements, a detecting unit that detects all pieces of additional

information that are embedded in image data, and a storage unit that stores the

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detected pieces of additional information in association with location information thereof.

In the detailed response to arguments in paragraph 1 of the Office Action, the Examiner continues to take the position that *Evans* detects a watermark and stores information concerning the watermark in association with location information of the watermark. The Examiner alleges that column 2, lines 25-30 and 61-65, of *Evans* describes "location information" as that term is used in claim 1. However, the Examiner appears to agree that the location information of claim 1 refers to the location of where the additional information is embedded in the image data.

The Examiner's response to arguments ignores the language in *Evans*. At column 2, lines 7-9 *Evans* provides that the document 30 includes a picture 31 that is encoded with a plural bit digital watermark. At column 2, lines 30-35, *Evans* provides that a database 34 searches its records 37 for a digital object indexed by the watermark and if located, causes a pristine version of the picture 31 to be sent to the photocopier. At column 2, lines 61-65 *Evans* provides that in addition to detecting an ID of any watermark in scanned image data the photocopiers watermark detector also discerns the placement of the watermarked <u>picture</u> within the document image. As stated at column 3, lines 29-30 the pristine picture 38 received from the server 32 can be watermarked or not. In light of these disclosures of *Evans* the Examiner's position is not supported.

In *Evans*, the watermark contains image data, and the image data from the watermark is used to form an image in the document to be reproduced. The "location information" referred to in *Evans* concerns the location (size, rotation, etc.) where the imported image is to be inserted into the original image. It does not concern the location of where the watermark itself is embedded in the image data.

Accordingly, *Evans* does not teach or suggest the claimed storage unit that stores the detected pieces of additional information in association with location information thereof. The "location" referred to in *Evans* is the location where image data contained in the watermark is subsequently to be inserted into the document. That section of *Evans* does not indicate that the watermark includes storage information concerning the location of where the watermark is embedded in the image data. If *Evans* was referring to the location of the watermark, it would not make sense to refer to "rotation."

With regard to column 2, lines 62 – 65, of *Evans*, Applicants submit that this teaches that the watermark detector discerns the placement of the imported image within the original image, not the location of the watermark itself. Accordingly, *Evans* does not teach or suggest the claimed storage unit.

Applicants' respectfully traverse the Examiner's assertion, in paragraph 3 of the Office Action, that *Evans* teaches that the watermark location is directly related to the location of the imported image. Applicants believe that this assertion is unsupported by the disclosure of *Evans*.

Independent claims 7, 13, 20 and 26-29 are allowable for similar reasons.
Ikenoue Does Not Overcome the Deficiencies of Evans.

Applicants' independent claim 29 recites, in combination with other claimed features, an image processing apparatus including an embedding unit that embeds a new piece of additional information including updated information into the image data at a location that does not overlap locations where the detected pieces of additional information are embedded by referring to the stored location information.

The Examiner recognizes that Evans does not expressly disclose that an embedding unit embeds, when a judgment result of the analyzing unit is negative, a

new piece of additional information including updated information into the first image

data at a location that does not overlap locations where the detected pieces of

additional information are embedded by referring to the stored location information.

The Examiner argues that Ikenoue's disclosure at column 6, lines 33-47, of new

information added where there is no information for each new generation copy code

when each generation of a copy is made, must be in new locations because older

generation codes already exist at their respective locations, or there is no copy code

if copy is first generation.

However, Ikenoue states if a generation code is not included in the image

data produced from a source, data on the generation code is always added when a

copy is produced, while if a source of the document 103 already includes a

generation code, a new modified generation code is added in subsequent hard

copies. Thus, the Examiner appears to be asserting that if a source of the document

already includes a generation code, then the new modified generation code must be

in a new location since older generation codes already exist at the respective

locations. However, this does not relate to where the claimed analyzing unit judges

that any of the detected pieces of additional information does not include

predetermined information that is updatable. If the Examiner alleges that "when the

generation code is not included in the image data" corresponds to "judging that the

detected pieces of additional information include predetermined information that is

not updatable" then, there is no disclosure in, nor is it necessary for, Ikenoue to

determine or refer to stored location information of the pieces of additional

information. If a generation code is not included in the image data then there simply

is no additional information. In the instance where there is no generation code there

will be no older generation code and therefore there is no reason to refer to the

stored location of the older generation code, and no reason to embed the new generation code at a location that does not overlap the old generation code.

Thus, Evans and Ikenoue, either alone or in combination, do not disclose, in combination with the other claimed features of claim 29, embedding, when the judgment result of the analyzing unit is negative, a new piece of additional information including updated information into the image data at a location that does not overlap locations where the detected pieces of additional information are embedded, by referring to the stored location information.

As discussed above, the U.S. Patent and Trademark Office has not established a *prima facie* case in support of the rejection because of the factual deficiencies in the rejections.

In the event there are any questions concerning this request, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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Date: <u>August 28, 2009</u>   By: _____

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